

### **REMARKS**

This is a reply to the Office Action dated September 1, 2009, in the above-referenced patent application. Applicant thanks the Examiner for carefully considering the application.

#### **Status of Claims**

Claims 1-11 and 13-20 are currently pending. Claims 1, 15 and 19 are independent.

Claims 1, 7 - 8, 15 and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,135,222 issued to Spector ("Spector"). Claims 1, 7 - 11, 13, 15, and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,409,733 issued to Conlon et al. ("Conlon"). Claims 2 - 5, 16 - 18, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spector in view of U.S. Patent No. 6,278,057 issued to Avellanet ("Avellanet") further in view of U.S. Patent No. 5,064,428 issued to Cope et al. ("Cope"). Claims 4 - 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Conlon in view of Avellanet. Claims 9 - 11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spector in view of Conlon. Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spector in view of U.S. Patent. No. 5,649,021 issued to Matey et al. ("Matey").

#### **Claim Amendments**

Claims 1, 15 and 19 are amended for clarification. No new matter is added.

**Rejections under 35 U.S.C. § 102(b)**

*Claims 1, 7-8, 15 and 19*

Rejection of claims 1, 7 - 8, 15 and 19 is respectfully traversed for at least the following reasons, Spector, does not teach, disclose or suggest all of the claimed limitations as amended.

According to MPEP §2131,

'[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete detail as is contained in the ... claim.' (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

Applicant's amended independent claim 1 requires, in part,

a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said *specimen pouch (1) is configured for receiving a biological specimen (9) during micro-invasive surgery through a small incision in a patient therein; A) said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass, wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7) (emphasis added).*

Applicant's independent claim 15 requires, in part,

an open end and a closed end, wherein the specimen retrieval *pouch is configured for receiving a biological specimen during micro invasive surgery through a small incision in a patient therein*, the flexible wall of the open end of the specimen pouch has discontinuous serration, *the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the string opens the specimen pouch when heated* (emphasis added).

Applicant's independent claim 19 requires, in part,

an open end and a closed end, wherein *the specimen retrieval pouch is configured for receiving a biological specimen during micro-invasive surgery through a small incision in a patient therein*, the flexible wall of the open end of the specimen pouch *has discontinuous serration, the serration includes channels through which a pouch deployment and retrieval string can pass*, wherein the pouch deployment and retrieval string opens and closes the specimen retrieval pouch, *wherein the string opens the specimen pouch when heated* (emphasis added).

Spector discloses a multi-mode playball and is not suited for use in a biological specimen retrieval environment. This is easily seen as the casing and drawstring of Spector is not suitable for insertion into a body, is not made of material typically used during surgery, is not sized to be used for surgery, would most likely cause infection due to the porous material, and could likely cause death if inserted into a human being and used to receive a biological specimen. Therefore, Spector is not in the same field of endeavor as Applicant's claimed invention (see *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007)). Thus, Spector is non-analogous art.

Furthermore, even though Applicant believes Spector is non-analogous art, Spector does

not disclose a specimen pouch that is *configured for receiving a biological specimen during micro-invasive surgery through a small incision in a patient* as claimed herein. As depicted in Figures 5 - 9 and 13 of Spector, the playball is apparently one-half of the height of a boy and is large enough to hold a paddle for example. (See Spector, column 5, lines 44 - 50). Hence, given the size of the playball as compared to the size of a small incision made in a patient during micro-invasive surgery, the playball taught by Spector is too large to be used to receive a biological specimen *during micro-invasive surgery*. Indeed, if the playball pouch of Spector were inserted into a body the result would most likely be death, tissue destruction or damage and infection.

In addition, Spector does not teach wherein the string opens the specimen pouch when heated as claimed herein. Instead, Spector requires that the opening of the casing 10 to be manually pulled apart to enlarge the opening of the playball. (See Spector, column 5, lines 44 - 50 and Figure 13).

Moreover, Spector discloses a ball with a large opening where said opening is encircled with V shaped notches with eyelets which are well known and capable of having a retrieval string, open spring, retrieval noose, etc., pass through. Fig. 1 of Spector shows the casing including in a multi-mode playball, and Fig. 4 shows how the opening of the casing is closed. In these figures, a drawstring is threaded through flaps of the casing, and is drawn tight to close the opening. This causes the flaps to draw together and thereby transform the V-shaped notches into narrow slits.

Distinguishable, in Applicant's claimed invention "[b]y the thermoplastic jointing, the slots 1-5 are shaped in the open end 1-2. We then cut the open end into the hackle shape 1-4, and make the open and retrieval string 2 pass through the slots 1-5 therein to connect with the distant end of the inner sheath." (see Applicant's specification, par. [0030]; Figs. 1, 2 and 3).

Applicant asserts that unobvious differences exist between the claimed product and the product taught by Spector. The claimed invention requires that *slots are shaped in the open end* of the specimen pouch. On the other hand, Spector discloses a drawstring 14 that weaves through adjacent eyelets 12 and 13 on a flap and then weaves to eyelets on the next adjacent flap. (See Spector, Figure 1). The drawstring thus enters the eyelets approximately normal to the plane of the fabric. Furthermore, the claimed invention requires a thermoplastic jointing of the flexible wall, whereas Spector teaches that the eyelets are simple holes in the fabric of the playball. Spector makes no mention of jointing materials together to form a conduit for a string.

Therefore, Spector does not teach or disclose

a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said specimen pouch (1) *is configured for receiving a biological specimen (9) during micro-invasive surgery through a small incision in a patient therein; on said serration (1-4), there are slots (1-5) through which a string can pass, wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end*

*in the specimen pouch and then the slipknot or slip block (7)*  
(emphasis added).

as required, in part, by amended claim 1,

*an open end and a closed end, wherein the specimen retrieval pouch is configured for receiving a biological specimen during micro invasive surgery through a small incision in a patient therein, the flexible wall of the open end of the specimen pouch has discontinuous serration, the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the string opens the specimen pouch when heated* (emphasis added),

as required, in part, by amended claim 15, nor

*an open end and a closed end, wherein the specimen retrieval pouch is adapted to receive a biological specimen during micro invasive surgery through a small incision in a patient therein, the flexible wall of the open end of the specimen pouch has discontinuous serration, the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the pouch deployment and retrieval string opens and closes the specimen retrieval pouch, where the string opens the specimen pouch when heated* (emphasis added)

as required, in part, by amended claim 19.

Since Spector does not teach, disclose or suggest all of Applicant's claims 1, 15 and 19 limitations, and is non-analogous art, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Spector. Thus, Applicant's claims 1, 15 and 19 are not anticipated by Spector. Additionally, the claims that directly or indirectly depend on claim 1, namely claims 7-8, are also not anticipated by Spector for at least the same reasons.

Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejections for claims 1, 7-8, 15 and 19 are respectfully requested.

*Claims 1, 7 - 11, 13, 15, and 19*

Rejection of claims 1, 7 - 11, 13, 15, and 19 is respectfully traversed for at least the following reasons, Conlon, does not teach, disclose or suggest all of the claimed limitations as amended.

Conlon discloses a specimen retrieval bag that includes a noose to close the specimen bag and spring arms that spread open into a “Y” to deploy (i.e., open) the specimen retrieval bag (Conlon, col. 4, lines 30-36, Fig. 2). The noose in Conlon extends around the periphery of the specimen bag (see Conlon, col. 4, lines 28-31). The noose in Conlon may allow the pouch to open via the spring arms, but cannot be used to actually open the pouch by itself. Therefore, Conlon cannot teach or suggest “the string *opens and closes the specimen pouch*, wherein the *string opens the specimen pouch when heated*” (emphasis added) as required, in part, by amended claim 1, or “wherein the *string opens the specimen pouch when heated*” (emphasis added) as required by amended claim 15, or “the *pouch deployment and retrieval string opens and closes the specimen retrieval pouch* wherein the *string opens the specimen pouch when heated*” (emphasis added) as required, in part, by claim 19.

Further, Conlon does not teach or disclose the pouch has a serration with slots or a channel through which the string passes. In Conlon, the string simply passes through the top

periphery of the specimen pouch. Therefore, it is clear that Conlon does not teach or disclose “*said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass*” (emphasis added) as required, in part, by amended claim 1, or “*the serration includes channels through which a pouch deployment and retrieval string can pass*” (emphasis added) as required, in part, by claims 15 and 19.

Applicant asserts that unobvious differences exist between the claimed product and the product taught by Conlon. The claimed invention requires that the flexible wall of the open end of the specimen pouch has *discontinuous serration*. Conlon teaches that the open end of the specimen pouch has a smooth edge without serrations. (See Conlon, Figure 9). Moreover, Conlon relies on intermittent weld lines to form areas that are stiff and less stiff, so that the open end buckles when the drawstring is pulled. (See Conlon, column 7, line 43 - 50). Furthermore, the claimed invention requires a thermoplastic jointing of the flexible wall, whereas Conlon teaches intermittent weld lines to join the fold wall to the wall. (See Conlon, column 7, lines 7 - 33).

Moreover, Conlon does not teach or suggest

*said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass, wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot*



*or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7) (emphasis added)*

as required, in part, by amended claim 1, or “the flexible wall of the open end of the specimen pouch has discontinuous serration, *the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the string opens the specimen pouch when heated*” (emphasis added),

as required, in part, by amended claim 15, nor

*the flexible wall of the open end of the specimen pouch has discontinuous serration, the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the pouch deployment and retrieval string opens and closes the specimen retrieval pouch, where the string opens the specimen pouch when heated* (emphasis added).

as required, in part, by amended claim 19.

Therefore, since Conlon does not teach, disclose or suggest all of Applicant’s claims 1, 15 and 19 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. § 102(b) has not been adequately set forth relative to Conlon. Thus, Applicant’s claims 1, 15 and 19 are not anticipated by Conlon. Additionally, the claims that directly or indirectly depend on claim 1, namely claims 7 - 11, and 13, are also not anticipated by Conlon for at least the same reason.

Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejections for

claims 1, 7 - 11, 13, 15, and 19 are respectfully requested.

**Rejections under 35 U.S.C. § 103(a)**

*Claims 2 - 5, 16 - 18, and 20*

Rejection of claims 2 - 5, 16 - 18, and 20 is respectfully traversed for at least the following reasons, Spector, Avellanet and Cope, whether considered separately or in combination do not teach, disclose or suggest all of the claimed limitations as amended.

According to MPEP § 2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP § 2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP § 2143.01, [o]bviousness can be established by combining or modifying the teachings of

the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007).

Additionally, according to MPEP § 2143

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

Claims 2 - 5 either directly or indirectly depend on amended claim 1. Claims 16-18 either directly or indirectly depend on claim 15. Claim 20 directly depends on claim 20. As asserted above, Spector is non-analogous art. Moreover, Spector does not teach, disclose or suggest all of Applicant’s claim 1 limitations of

a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said specimen pouch (1) *can receive a biological specimen (9) during micro-invasive surgery through a small incision in a patient therein; on said serration (1-4), there are slots (1-5) through which a string can pass, wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into*

*said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7) (emphasis added),*

Applicant's independent claim

15 limitations of

*an open end and a closed end, wherein the specimen retrieval pouch is configured for receiving a biological specimen during micro invasive surgery through a small incision in a patient therein, the flexible wall of the open end of the specimen pouch has discontinuous serration, the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the string opens the specimen pouch when heated (emphasis added),*

nor Applicant's independent claim 19 limitations of

*an open end and a closed end, wherein the specimen retrieval pouch is configured for receiving a biological specimen during micro invasive surgery through a small incision in a patient therein, the flexible wall of the open end of the specimen pouch has discontinuous serration, the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the pouch deployment and retrieval string opens and closes the specimen retrieval pouch, where the string opens the specimen pouch when heated (emphasis added).*

Avellanet discloses the use of nickel-titanium wire strands instead of a superelastic nickel-titanium wire for increased elasticity. Avellanet further discloses that elastic wires are used to enlarge a loop and to constrict a loop. Avellanet also discloses that the wire may be trained to naturally assume the desired enlarged size. Avellanet, however, does not teach that the strands of wire or a wire by itself, would be inserted below an operating temperature and designed to enlarge based on body temperature.

Cope discloses that when a nitinol wire is used below its operating temperature that heat must be used to return the wire to its original shape. Cope further teaches that the operating temperature used in the basket is used above its transformation temperature. Therefore, Cope teaches that the basket is always used in its original shape (Cope, col. 2, lines 61-65). Therefore, there is no need in Cope to lower the temperature before inserting the device into a body. Thus, Cope teaches away from the present invention where “*said string (2) is made of any materials which can save the changed shape and return to the original or near the original shape when disentangled*” (emphasis added) as required, in part, by claim 2, “*the pouch deployment and retrieval string returns to its original shape based on temperature*” (emphasis added) as required, in part, by claim 17, or “*the pouch deployment and retrieval string returns to an open state based on temperature of a body*” (emphasis added) as required, in part, by claim 20.

Even if it were legal to combine Spector, Avellanet and Cope (which Applicant traverses), Spector does not teach, disclose or suggest the limitations contained in claims 1, 15 and 19. Moreover, adding nitinol to a playball pouch does not make any logical sense and there would not be any motivation to do so. Even if one did add a nitinol wire to Spector’s playball pouch, it would change the principle of operation (see MPEP 2143.01 VI, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Moreover, the discontinuous serration in Applicant’s claimed invention reduces the size

of the specimen pouch so that the specimen pouch with a large open end could easily pass through a small surgical cut and diminish the resistance when pulling the specimen pouch out through the small surgical cut. In the prior art, if the open end of a specimen pouch is too large (e.g., the diameter of the open end is greater than 80mm), then the specimen pouch could not pass through a small surgical cut, such as a cut less than 10mm wide. Therefore, in the prior art a cut would need to be enlarged, which causes complications such as larger scars, further suturing, a higher chance of infection, etc. As easily seen by an ordinary person skilled in the art, it would be impossible to insert the playball pouch of Spector into a biological body without causing severe trauma.

Further, even if Spector can be legally combined with Avellanet and Cope, which Applicant traverses, the combined result does not teach, disclose or suggest

*a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said specimen pouch (1) is configured for receiving a biological specimen (9) during micro-invasive surgery through a small incision in a patient therein; A) said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass, wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7) (emphasis added)*

as required, in part, by amended claim 1,

an open end and a closed end, *wherein the specimen retrieval pouch is configured for receiving a biological specimen during micro-invasive surgery through a small incision in a patient therein*, the flexible wall of the open end of the specimen pouch has discontinuous serration, *the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the string opens the specimen pouch when heated* (emphasis added),

as required, in part, by claim 15, or

an open end and a closed end, wherein the *specimen retrieval pouch is configured for receiving a biological specimen during micro-invasive surgery through a small incision in a patient* therein, the flexible wall of the open end of the specimen pouch has discontinuous serration, *the serration includes channels through which a pouch deployment and retrieval string can pass, wherein the pouch deployment and retrieval string opens and closes the specimen retrieval pouch, where the string opens the specimen pouch when heated* (emphasis added)

as required, in part, by claim 19.

Still further, the assertions made in the Office Action on pages 6 and 7 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP § 2142 cannot be found. Additionally, since neither Spector, Avellanet, Cope, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's claims 1, 15 and 19, as listed above, Applicant's claims 1, 15 and 19 are not obvious over Spector in view of Avellanet and Cope since a *prima facie* case of obviousness has not been met under MPEP § 2143. Additionally, the claims that directly or indirectly depend from amended claims 1, 15 and 19, namely claims 2-5, 16-18, and 20, respectively, would also not be obvious over Spector in view of Avellanet and Cope for at least the same reasons.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claims 2-5, 16-18 and 20 is respectfully requested.

*Claims 4-6*

Rejection of claims 4-6 and 9-13 is respectfully traversed for at least the following reasons, Conlon, and Avellanet, whether considered separately or in combination, do not teach, disclose or suggest all of the claimed limitations as amended.

Dependent claims 4-6 either directly or indirectly depend on amended claim 1. As asserted above, the combination of Conlon, and Avellanet, even if legally allowed (which Applicant traverses), does not teach, disclose or suggest

*said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass, wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7) (emphasis added)*

as required, in part, by independent claim 1.

As asserted above, the noose in Conlon extends around the periphery of the specimen bag (see Conlon, col. 4, lines 28-31). The noose in Conlon may allow opening of a specimen bag,



but cannot be used to actually open the pouch itself. Therefore, Conlon cannot teach or suggest “the string *opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated*” (emphasis added) as required, in part, by amended claim 1.

Further, Conlon does not teach or disclose the pouch has a serration with slots or a channel through which the string passes. In Conlon, the string simply passes through the top periphery of the specimen pouch. Therefore, it is clear that Conlon does not teach or disclose “*said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass*” (emphasis added) as required, in part, by amended claim 1.

Still further, the assertions made in the Office Action on page 7 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP § 2142 cannot be found. Additionally, since the combination of Conlon, and Avellanet is not proper, Applicant's amended claim 1 is not obvious over Conlon in view of Avellanet since a *prima facie* case of obviousness has not been met under MPEP § 2143. Additionally, the claims that directly or indirectly depend from amended claim 1, namely claims 4-6, would also not be obvious over Conlon in view of Avellanet for at least the same reasons.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claims 4-6 is respectfully requested.

*Claims 9-13 and 13*

Rejection of claims 9 - 11 and 13 is respectfully traversed for at least the following reasons, Spector, and Conlon, whether considered separately or in combination, do not teach, disclose or suggest all of the claimed limitations as amended.

Dependent claims 9 - 11 and either directly or indirectly depend on amended claim 1. As asserted above, the combination of Spector and Conlon, even if legally allowed (which Applicant traverses), does not teach, disclose or suggest

a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said specimen pouch (1) is configured for receiving *a biological specimen (9) during micro-invasive surgery through a small incision in a patient* therein; A) said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass, *wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7)* (emphasis added),

as required, in part, by independent claim 1.

As asserted above, the noose in Conlon extends around the periphery of the specimen bag (see Conlon, col. 4, lines 28-31). The noose in Conlon cannot actually be used to open the pouch itself. Therefore, Conlon cannot teach or suggest “the string *opens and closes the specimen*

*pouch, wherein the string opens the specimen pouch when heated*” (emphasis added) as required, in part, by amended claim 1. Further, Conlon does not teach or disclose the pouch has a serration with slots or a channel through which the string passes. In Conlon, the string simply passes through the top periphery of the specimen pouch. Therefore, it is clear that Conlon does not teach or disclose “*said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass*” (emphasis added) as required, in part, by amended claim 1.

Additionally, there would be no need to employ a string that can return to a certain size in a playball pouch of Spector. In fact, this would teach away from Spector where the point of the string is to keep the playball inside the pouch. Therefore, adding the teachings of Conlon to Spector would change the principle of operation of Spector (see MPEP 2143.01 VI, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Moreover, by viewing the disclosures of Spector and Conlon, one cannot jump to the conclusion of obviousness without impermissible hindsight. According to MPEP 2141.01, “[t]he requirement ‘at the time the invention was made’ is to avoid impermissible hindsight.”

‘[i]t is difficult but necessary that the decisionmaker forget what he or she has been taught ... about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art.’ W.L. Gore &

Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303,  
313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Applicant submits that without first reviewing Applicant's disclosure, no thought whatsoever, would lead to "said flexible wall of the open end of *the specimen pouch has discontinuous serration (1-4)*; B) on said serration (1-4), there are slots (1-5) through which string (2) can pass, wherein *the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated*," (emphasis added), nor "*said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7)*" (emphasis added) as required, in part, by amended claim 1.

Further, the assertions made in the Office Action on pages 8 - 9 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP § 2142 cannot be found. Additionally, since the combination of Spector and Conlon is not proper, Applicant's amended claim 1 is not obvious over Spector in view of Conlon since a *prima facie* case of obviousness has not been met under MPEP § 2143. Additionally, the claims that directly or indirectly depend from amended claim 1, namely claims 9 - 11 and 13, would also not be obvious over Spector in view of Conlon for at least the same reasons.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claims 9 - 11 and 13 is respectfully requested.

*Claim 14*

Rejection of claim 14 is respectfully traversed for at least the following reasons, Spector and Matey, whether considered separately or in combination do not teach, disclose or suggest all of the claimed limitations as amended.

Dependent claim 14 directly depends on amended claim 1. As asserted above, Spector is non-analogous art. Further, Spector does not teach, disclose or suggest

a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said specimen pouch (1) is configured for receiving *biological specimen (9) during micro-invasive surgery through a small incision in a patient* therein; A) said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass, *wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7)* (emphasis added),

as required, in part, by independent claim 1.

Matey discloses a tool (laparoscope) that is marked with a color not found in an abdomen.

The reason Matey does this is so the detector can detect the laparoscope. This is completely different than Applicant's claimed invention. In Applicant's claimed invention, a laparoscope is used to guide a physician so that a biological specimen can be placed in the specimen pouch. The coloring of the pouch makes it easy for the physician to differentiate the pouch from the specimen, which makes it easier for the physician to place the specimen in the pouch and reduces mistakes.

Further, combining the laparoscope of Matey with a playball pouch of Spector makes no logical sense, and there would never be motivation to do so. Even if the teachings of Matey are combined with those of Spector legally, the combination would not teach, disclose or suggest

a flexible wall (1-1), an open end (1-2) and a closed end (1-3), and said specimen pouch (1) is configured for receiving *biological specimen (9) during micro-invasive surgery through a small incision in a patient* therein; A) said flexible wall of the open end of the specimen pouch has discontinuous serration (1-4); B) on said serration (1-4), there are slots (1-5) through which a string can pass, *wherein the string opens and closes the specimen pouch, wherein the string opens the specimen pouch when heated, wherein said slots (1-5) are shaped in the open end (1-2) of the specimen pouch by a thermoplastic jointing of the flexible wall (1-1), and then the flexible wall (1-1) of the open end (1-2) is cut into said discontinuous serration (1-4); wherein one end of the said string (2) is connected with a slipknot or slip block (7), a noose structure is formed when the other end passes through the slots (1-5) in the serration (1-4) of the open end in the specimen pouch and then the slipknot or slip block (7)* (emphasis added),

as required, in part, by independent claim 1.

Still further, the assertions made in the Office Action on page 9 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP § 2142 cannot be found. Additionally, since neither Spector, Matey, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's amended claim 1, as listed above, Applicant's amended claim 1 is not obvious over Spector in view of Matey since a *prima facie* case of obviousness has not been met under MPEP § 2143. Additionally, the claim that directly depends from amended claim 1, namely claim 14, would also not be obvious over Spector in view of Matey for at least the same reasons.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection for Claim 14 is respectfully requested.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant believes that the claims are in condition for allowance. Reconsideration, re-examination, and allowance of all claims are respectfully requested. If the Examiner feels that a telephone interview may help further the examination of the present application, the Examiner is encouraged to call the undersigned attorney or his associates at the telephone number listed below.

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Respectfully submitted,

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